

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	Harrington et al.	Examiner:	Tekchand Saidha
Serial No.	09/586,744	Art Unit:	1652
Filed:	June 2, 2000	Confirmation No.	7865

Title: MAMMALIAN FLAP-SPECIFIC ENDONUCLEASE

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**PETITION UNDER 37 C.F.R. § 1.181 REQUESTING RECONSIDERATION OF  
DECISION DENYING PETITION TO EXPUNGE AN IMPROPERLY ENTERED  
THIRD PARTY PROTEST**

ATTN: DIRECTOR BRUCE KISLIUK  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**I. RELIEF REQUESTED**

Petitioner requests reconsideration of the Petition Decision dated March 30, 2005 denying Petitioner's Request for Reconsideration of its Petition under 37 CFR §1.181 to Expunge an Improperly Entered Third Party Protest.

**II. STATEMENT OF FACTS**

The captioned reissue application was filed on June 6, 2000 based on U.S. Patent No. 5,874,283, issued February 23, 1999. To date, three Third Party Protests have been filed by the same party: the first on January 3, 2001 ("the "First Protest"), a second on January 9, 2002 (the "Second Protest"), and a third on August 13, 2004 (the "Third Protest"). Each of the protests has been entered into the record of the instant reissue application. Petitioner submitted a Response rebutting the merits of the First Protest on February 14, 2001. A Response to the Second Protest stating that it was improperly entered, and also pointing out its lack of merit, was filed on May 22, 2002. On October 5, 2004, Petitioner submitted a Petition under 37 §CFR 1.181 (the "Petition") requesting that the Third Protest be expunged from the record of the

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instant application on the grounds that it does not comply with 37 CFR § 1.291(c). The Petition was denied in a Decision dated January 13, 2005 (the "first Decision").

On March 14, 2005, Petitioner requested reconsideration of the first Decision, again pointing out that the Third Protest does not comply with 37 CFR § 1.291(c). A Decision denying Petitioner's request was mailed March 30, 2005 (the "second Decision"). Reconsideration of this second Decision is requested.

### III. ARGUMENT

#### A. The Patent Office Has Applied an Improper Standard

The crux of the Patent Office's decision to deny Petitioner's request for reconsideration appears to lie in the following sentence:

However, a third party protestor has a right and obligation to raise new issues with respect to a reissue application bearing on patentability and which the Office may or may not be aware of.

Second Decision at second paragraph. This assertion misstates the rules.

As pointed out in Petitioner's prior Request for Reconsideration, the involvement in an application by members of the public filing a protest is governed by 37 CFR § 1.291(c). This rule does not grant protestors the rights asserted in the second Decision. Rather, this rule specifies that:

*The limited involvement of a member of the public filing a protest pursuant to paragraph (a) of this section ends with the filing of the protest, and no further submission on behalf of the protestor will be considered, except for additional prior art, or unless such submission raises new issues which could not have been earlier presented.*

37 CFR § 1.291(c) (emphasis supplied). As indicated by the italicized language, the rights of protestors to file further submissions is significantly more limited than indicated in the second Decision.

Moreover, consideration of whether a protestor's further submissions satisfy the criteria of 37 CFR § 1.291(c) is a *threshold* issue; submissions that do not satisfy § 1.291(c) should not be

entered into the application file. They should be returned to the protestor by the Technology Center Director:

Protests which *will not* be entered in the application include those further submissions *in violation of 37 CFR §1.291(c)* by which protestor seeks to participate in the examination process.

\* \* \*

Improper protests will be refused consideration by the Technology Center (TC) Director.

MPEP §1901.07(a) (emphasis supplied).

**B. The Third Protest Violates 37 CFR §1.291(c)**

There can be no doubt the Third Protest violates 37 CFR §1.291(c) and therefore should not have been entered into the record of the instant reissue application. It raises neither new prior art nor new issues that could not have been presented earlier.<sup>1</sup>

*All of the issues presented in the Third Protest merely repeat, or are variations of, the Protestor's previous meritless arguments. There is nothing of substance in the Third Protest that could not have been stated in the First Protest. Indeed, many of the issues presented in the Third Protest were already raised in the First Protest.*

For example, at pages 8-14, the Protestor argues that the instant reissue application is improper. The same issue was presented, and the same arguments made, by the protestor in its First Protest (*see, e.g.*, First Protest at pages 12-25). Inclusion of this same issue and arguments, standing alone, mandates that the Third Protest be expunged from the record:

*Even new protests which also argue Office actions or replies or any matter beyond the new issue should not be accepted.*

MPEP §1901.07(a) (emphasis supplied). Thus, even assuming, *arguendo*, that the Third Protest contained a new issue that could not have been presented earlier that it should not have been entered into the record because it also included matter *beyond* any such new issue.

<sup>1</sup> The second Decision states that the arguments presented in the Third Protest relate "to either new prior art or interpretation of references already considered." The arguments in the Third Protest do neither. No new art is cited by the protestor. Nor is art already of record discussed by the protestor. Moreover, *even if* the Third Protest included arguments relating to "interpretation of art already of record," those arguments would not be admissible. 37 CFR §1.291(c) speaks to "new prior art," not to interpretations of art already of record.

The Protestor argues the issues presented in the Third Protest are new issues that could not have been presented earlier because they were created by Petitioner's Amendments and arguments:

Because these issues were created by Applicant's latest Amendment and arguments, they could not have been presented earlier.

\* \* \*

A number of these new arguments relate to Applicant's incorrect and/or misleading statements or arguments.

Third Protest at page 4. The Protestor's reasoning conveniently ignores the fact that the MPEP makes abundantly clear that arguments relating to an applicant's reply to an Office action *do not qualify as new issues*:

For example, mere arguments relating to an office action or an applicant's reply *would not qualify as a new issue*.

MPEP § 1901.07(a) (emphasis supplied).

The Patent Office should not be duped by the Protestor's circular logic. The MPEP clearly states that issues and arguments relating to an Applicant's reply are not "new." Such issues and arguments cannot be "bootstrapped" into being "new," and therefore somehow proper under 37 CFR §1.291(c), by stating that they could not have been presented earlier merely because they relate to an applicant's amendment and reply. Rule 291(c) requires that further submissions by a protestor must either include new prior art or *new issues that could not have been presented earlier*. Issues and arguments that the MPEP specifically states *are not new* can *never* satisfy this standard. Adapting the Protestor's circular logic would completely vitiate 37 CFR §1.291(c).

As evidenced by the above discussion, the rules of practice governing the entry of supplemental and/or subsequent protests are clear. Under the rules, the Third Protest (and also the Second Protest), should not have been entered into the instant application because it violates 37 CFR § 1.291(c). The merits of its arguments are simply irrelevant to the threshold issue of whether the protest complies with the rules. It does not, and, as a consequence, it should not have been entered into the application.

Since the second Decision appears to apply a standard not contemplated by the rules of practice, reconsideration of this Decision in light of the proper standard is respectfully requested. Specifically, Petitioner again requests that the Third Protest be expunged from the record on the ground that it violates 37 CFR § 1.291(c). Moreover, since the Office Action mailed September 14, 2004 incorporates information that should have never been considered in the first place, Petitioner also reiterates its request that this Office Action be withdrawn.

Petitioner also notes for the record that granting its original Petition is not only consistent with the rules of practice, it is consistent with the policy considerations underlying the rules. Indeed, in 1982, Rule 291(c) was explicitly amended to prevent the very behavior occurring in the instant case: attempts by third party adversaries to prolong the time and cost of examination by participating *inter parte*, under the guise of the protest process, in the *ex parte* examination process. See, e.g., *In re Blaese*, 19 USPQ2d 1232, 1235 (Comr Pats 1991) and 47 Fed. Reg. 21746.

The amendment to Rule 291(c) was specifically designed to ensure that examination proceedings are essentially *ex parte*. 47 Fed. Reg. at 21749, Col. 2. Moreover, in the notice proposing to amend Rule 291, the Patent Office explained that the proposed rule change was designed to reduce the prosecution costs of patent applications by limiting the amount of participation by protestors during the patent application examining process. 46 Fed. Reg. 55666, Col. 2. The instant Protester has now filed *three protests* in the instant reissue application. The first after the filing of the application, the second in response to Petitioner's Amendments of June 15, 2001 and this third in response to Petitioner's Amendments of August 13, 2003 and May 18, 2004. Thus, the Protester has filed a protest *in response to each Amendment submitted by Petitioner*.

The rules regulating third party protests fully contemplated, and were specifically amended to protect against, the prejudicial and disruptive effect that permitting members of the public to participate *inter partes* in the *ex parte* examination process would have on patent applicants. The Patent Office's continued insistence on ignoring its own rules is causing Petitioner to be subjected to the very behavior that the rules were designed to prohibit.

#### IV. CONCLUSION

In view of the foregoing, Petitioner requests that the second Decision be reconsidered and that the Third Protest be expunged from the record. If, for some reason, the Patent Office still believes entry of the Third Protest was proper, Petitioner requests an explanation of the basis by which each and every issue and argument included in the Third Protest qualifies as a new issue that could not have been presented earlier, as required by 37 CFR § 1.291(c).<sup>2</sup> In addition, Petitioner requests that a new final Office Action be issued that is untainted by an interested third party's improperly entered views.

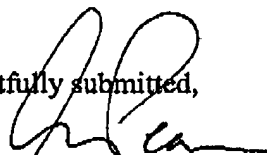
Submitted with this paper is the required fee set forth in 37 CFR 1.17(h). Petitioner submits that the Petition is timely filed and believes that no other fees are due. However, the Commissioner is authorized to charge additional fees which may be required, including extension fees, or credit any overpayment, to Dechert LLP Deposit Account No. 50-2778 (Our Order No. 375461-043R1).

Please direct any telephone calls concerning this application to the undersigned attorney at the number provided below.

Dated: May 31, 2005

By:

Respectfully submitted,



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<sup>2</sup> The second Decision states that "[b]oth the second and third protests raise, or appear to raise, a new issue of patentability not previously considered by the Office and arose only in response to applicants' reply to an outstanding Office action." This "justification" for entering the Third Protest into the record suffers from the same flaw of circular logic applied by the Protestor, discussed above. Moreover, to the extent the Third Petition was entered because it "appears" to raise a new issue, Petitioner reminds the Patent Office that mere "appearance" is not the standard. As stated in MPEP § 1901.07(a): "No further submissions on behalf of a protestor will be considered . . . unless such submission *clearly* raises a new issue which could not have been presented earlier."